

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application. Applicant also thanks the Examiner for courtesies extended in a telephone interview on February 14, 2005 to clarify the rejections.

Applicant respectfully requests an initialed copy of the Form PTO-1449 attached to the Information Disclosure Statement filed on September 19, 2003, or if the Information Disclosure Statement has not already been considered, prompt consideration of the same.

Disposition of Claims

Claims 1-23 are pending in this application. Claims 1, 10 and 18 are independent. The remaining claims depend, directly or indirectly, from claims 1, 10 and 18.

Amendments to Claims

Claims 1, 10, and 18 have been amended by this reply to include the limitation suggested on page 5, lines 4-5, of the office action and discussed during the telephone interview of February 14, 2005. Specifically, the limitation "in a proximal to distal direction" has been amended to "in a first proximal phalanx to a first distal phalanx direction." No new matter has been introduced by these amendments.

Double Patenting

Claims 1-23 were rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-55 of U.S. Application 10/032,604, which has been issued as U.S. Patent No. 6,874,258 on April 5, 2005. A terminal disclaimer pursuant to 37 C.F.R. §1.321(c) is included in this Reply, disclaiming the terminal part of the statutory term of any patent granted on this application, which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,874,258. Accordingly, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C § 112

Claims 1-23 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1, 10, and 18 have been amended to clarify that the direction is “in a first proximal phalanx to a first distal phalanx direction,” as suggested on page 5 of the office action. Accordingly, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C § 102

(A) Claims 1-3 and 6 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,092,314, issued to Rothbart (“Rothbart”). Claim 1 has been amended by this reply per Examiner’s suggestion to clarify the direction of the incline angle. To the extent the rejection may still apply to the amended claims, it is respectfully traversed.

Amended claim 1 recites “an orthopedic appliance, comprising a wedge adapted to be placed under the phalanges of a toe and to not extend under the center of a first metatarsal, the wedge having a top surface adapted to support the toe and a bottom surface, wherein the wedge is inclined such that when properly sized and placed, an angle of inclination between the top surface and the bottom surface of the wedge deflects a proximal phalanx of the toe between 1 and 60 degrees upwardly *in a first proximal phalanx to a first distal phalanx direction*, relative to the first metatarsal.”

In contrast, the apparatus of Rothbart is inclined *across* the medial column of the foot, but not *in a first proximal phalanx to a first distal phalanx direction*, as required by amended claim 1. Therefore, Rothbart fails to show or suggest the present invention as recited in amended claim 1. Thus, claim 1 is patentable over Rothbart. Dependent claims 2-3 and 6 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

(B) Claims 1, 5, and 10-11 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 4,333,472, issued to Tager (“Tager”). Claims 1 and 10 have been amended by this reply per Examiner’s suggestion to clarify the direction of the incline angle. Specifically, claims 1 and 10 have been amended to recite that the claimed apparatus deflects the proximal phalanx upwardly relative to the first metatarsal, *in a first proximal phalanx to a first distal phalanx direction*. To the extent that this rejection may still apply to the amended claims, it is respectfully traversed.

Tager discloses a series of differentially-sized geometrically-shaped prosthetic devices to be disposed in footwear. These devices may be situated underneath a region extending from the calcaneum bone of the rear foot (See Fig. 7 and Col. 4, ll. 9-14) to the first metatarsal/first phalanx region (See Fig. 9 and Col. 4, ll. 35-37). However, Tager fails to suggest or disclose an upwardly deflection of a proximal phalanx relative to a first metatarsal, *in a first proximal phalanx to a first distal phalanx direction*, as required by the amended claims.

For at least this reason, amended claims 1 and 10 are patentable over Tager. Claims 5 and 11, which depend from claims 1 and 10, respectively, are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Rejections under U.S.C. § 103

(A) Claims 4-5 were rejected under 35 U.S.C. § 103 as being obvious over Rothbart. Claims 4-5 depend from amended claim 1. Claim 1 has been amended by this reply per Examiner's suggestion to clarify the direction of the incline angle. To the extent that this rejection may still apply to the amended claims, it is respectfully traversed.

As noted above, claim 1 has been amended to include that the upwardly deflection of the proximal phalanx relative to the first metatarsal occurs *in a first proximal phalanx to a first distal phalanx direction*. Because Rothbart fails to show or suggest this limitation, claim 1 is patentable over Rothbart. Claims 4 and 5, which depend from claim 1, are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

(B) Claims 7-9 were rejected under 35 U.S.C. § 103 as being obvious over Rothbart in view of either Brock '927 or Jacoby '046. Claims 7-9 depend from amended claim 1. Claim 1 has been amended by this reply per Examiner's suggestion to clarify the direction of the incline angle. To the extent that this rejection may still apply to the amended claims, it is respectfully traversed.

As noted above, the apparatus of Rothbart does not deflect a proximal phalanx upwardly relative to a first metatarsal *in a first proximal phalanx to a first distal phalanx direction*. Neither Brock '927 nor Jacoby '046 discloses or suggests that which Rothbart fails to teach. Therefore, amended claim 1 is patentable over the combination of these references. Dependent

claims 7-9 are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

(C) Claims 7-9, and 15-23 were rejected under 35 U.S.C. § 103 as being obvious over Tager in view of either Brock '927 or Jacoby '046. These claims depend from claims 1, 10, and 18, which have been amended to clarify that the incline angle is *in a first proximal phalanx to a first distal phalanx direction*. To the extent that the rejection may still apply to the amended claims, it is respectfully traversed.

As note above, neither Rothbart nor Tager teaches or suggests deflecting a proximal phalanx upwardly relative to a first metatarsal, *in a first proximal phalanx to a first distal phalanx direction*, as required by independent claims 1, 10 and 18. Furthermore, neither Brock '927 nor Jacoby '046 discloses or suggests that which Rothbart and Tager fail to teach.

Accordingly, amended claims 1, 10, and 18 are patentable over the combination of these references. Claims 7-9, 15-17, and 19-23, which depend from amended claims 1, 10 and 18, are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

(D) Claims 18-23 were rejected under 35 U.S.C. § 103 as being obvious over Tager. Claim 18 has been amended to clarify that the incline angle is *in a first proximal phalanx to a first distal phalanx direction*. To the extent that this rejection may still apply to the amended claims, it is respectfully traversed.

As noted above, Tager fails to suggest or disclose an upwardly deflection of a proximal phalanx relative to a first metatarsal, *in a first proximal phalanx to a first distal phalanx direction*, as required by the amended claim 18. Therefore, claim 18 and the claims depending therefrom are patentable over Tager. Accordingly, withdrawal of this rejection is respectfully requested.

(E) Claims 10-14 stand rejected under 35 U.S.C. § 103 as being obvious over Rothbart in view of Tager. Independent claim 10 has been amended in this response to clarify that the incline angle is *in a first proximal phalanx to a first distal phalanx direction*. To the extent that this rejection may still apply to the amended claims, it is respectfully traversed.

As noted above, neither Rothbart nor Tager discloses or suggests deflecting a proximal phalanx upwardly relative to a first metatarsal, *in a first proximal phalanx to a first distal phalanx direction*, as required by independent claim 10. Therefore, amended claim 10 is patentable over the combination of these references. Claims 11-14, which depend from amended claim 10, are patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

(F) Claims 15-23 were rejected under 35 U.S.C. 103(a) as being obvious over the Rothbart in view of Tager and further in view of either Brock or Jacoby. Independent claims 10 and 18 have been amended to clarify that the incline angle is *in a first proximal phalanx to a first distal phalanx direction*. To the extent that this rejection may still apply to the amended claims, it is respectfully traversed.

As noted above, Rothbart, Tager, Brock, and Jacoby all fail to teach or suggest deflecting a first phalanx *in a first proximal phalanx to a first distal phalanx direction*. Therefore, claims 10 and 18, and their dependent claims 15-17 and 19-23, are patentable over the combination of these references. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

The Applicant believes this reply to be responsive to every issue raised in the Office Action. If this belief is incorrect, or other issues arise, please do not hesitate to contact the undersigned or his associates at the telephone number listed below. This application is now considered to be in condition for allowance and favorable action in the form of a Notice of Allowance is respectfully requested. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09166/002001).

Respectfully submitted,

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